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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/683,298	12/11/2001	John A. Richards	3421.1	1430

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EXAMINER

TRAN, MY CHAU T

ART UNIT PAPER NUMBER

1639

DATE MAILED: 12/13/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/683,298

Applicant(s)

RICHARDS, JOHN A.

Examiner

My-Chau T. Tran

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-33 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-4, drawn to a method of fabricating an array of biological probes, classified in class 435, subclass 4.
 - II. Claims 5-22, drawn to an apparatus, classified in class 435, subclass 287.3.
 - III. Claims 23-26, drawn to a method, classified in class 436, subclass 55.
 - IV. Claims 27-29, drawn to a system for generating spotted probe arrays, classified in class 422, subclass 105.
 - V. Claims 30-31, drawn to a method for registering a print head with respect to a surface, classified in class 221, subclass 1.
 - VI. Claim 32, drawn to an apparatus for registering deposit elements with respect to a surface of a substrate, classified in class 435, subclass 287.1.
 - VII. Claim 33, drawn to a method for registering deposit elements with respect to a surface of a substrate, classified in class 221, subclass 2.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions of Groups I, III, V, and VII are unrelated independent inventions. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions as claimed have different method steps that have different functions and modes of operation.

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The method step of providing a substrate having a surface to support the probes of Group I is not required by the claims of Groups III, V, and VII. The method step of enabling movement of biological elements around a first axis perpendicular to a depositing surface of Group III is not required by the claims of Groups I, V, and VII. The method step of moving the print head in a yaw direction so that it is aligned with respect to a yaw reference of Group V is not required by the claims of Groups I, III, and VII. The method step of rotating the deposit elements around a first axis perpendicular to the surface of Group VII is not required by the claims of Groups I, V, and V.

3. Inventions of Groups II, IV, and VI are unrelated independent inventions. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions as claimed have different required components that have different functions and effects.

The feature with *only* a plurality of deposit elements, and a first, second, and third mounting assembly of Group II is not required by the claims of Groups IV and VI. The feature of an arrayer and a computer of Group IV are not required by the claims of Groups II and VI. The feature of the mounting assembly constructed and arranged to rotate of Group VI is not required by the claims of Groups II and IV.

4. Inventions of Group II (apparatus) and Group I (process) are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the

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process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process.

(MPEP § 806.05(e)). In this case the apparatus as claimed can be used to practice another and materially different process such as dispensing reagents or pipetting samples. This restriction requirement is also applicable with the apparatus of Group IV and VI.

5. Inventions of Group II (apparatus) and Group III (process) are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process.

(MPEP § 806.05(e)). In this case the apparatus as claimed can be used to practice another and materially different process such as dispensing reagents or pipetting samples or Group VI. This restriction requirement is also applicable with the apparatus of Group IV and VI.

6. Inventions of Group II (apparatus) and Group V (process) are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process.

(MPEP § 806.05(e)). In this case the apparatus as claimed can be used to practice another and materially different process such as dispensing reagents or pipetting samples. This restriction requirement is also applicable with the apparatus of Group IV and VI.

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7. Inventions of Group II (apparatus) and Group VI (process) are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the apparatus as claimed can be used to practice another and materially different process such as dispensing reagents or pipetting samples or Group I. This restriction requirement is also applicable with the apparatus of Group IV and VI.

8. Because these inventions are distinct for the reasons given above and the searches required are not co-extensive thus requiring a burdensome search, restriction for examination purposes as indicated is proper. Additionally, different patentability considerations are involved for each group. For example, a patentability determination for Group V would involve a determination of the patentability of the method step of moving the print head in a yaw direction so that it is aligned with respect to a yaw reference while a patentability determination for Group II would involve a consideration of the patentability of the combination of an arrayer and a computer (independent of its use). These considerations are very different in nature.

9. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to My-Chau T. Tran whose telephone number is 703-305-6999. The examiner is on ***Increased Flex Schedule*** and can normally be reached on Monday: 8:00-2:30; Tuesday-Thursday: 7:30-5:00; Friday: 8:00-3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew J. Wang can be reached on 703-306-3217. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 for regular communications and 703-872-9307 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1123.

mct
December 11, 2002


PADMASHRI PONNALURI
PRIMARY EXAMINER